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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,930	10/15/2001	Christopher B. Howe		9263

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EXAMINER

BELL, KENT L

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 01/23/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/574,930

Applicant(s)

HOWE

Examiner

KENT L. BELL

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on application filed 10/15/01
- 2a) ☐ This action is FINAL.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/28/00 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**Detailed Action**

**Status of Application**

The instant application has been given the filing date October 15, 2001.

**Title**

The title should be directed to the plant.

The following title is suggested:

*Sedum purpureum* Plant Named 'Pink Chablis'.

**Objection to the Disclosure**

**37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

**35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Detailed Action**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

A. The disclosure is objected to because the specification is not properly arranged.

Applicant's attention is drawn to 37 CFR 1.163(c)-(d) which is reproduced below:

**Detailed Action**

37 CFR 1.163. Specification and arrangement of application elements in a plant application.

(c) The specification should include the following section in order:

- (1) Title of the invention, which may include an introductory portion stating the name, citizenship, and residence of the applicant.
- (2) Cross-reference to related applications (unless included in the application data sheet).
- (3) Statement regarding federally sponsored research or development.
- (4) Latin name of the genus and species of the plant claimed.
- (5) Variety denomination.
- (6) Background of the invention.
- (7) Brief summary of the invention.
- (8) Brief description of the drawing.
- (9) Detailed botanical description.
- (10) A single claim.
- (11) Abstract of the disclosure.

(d) The text of the specification or sections defined in paragraph (c) of this section, if applicable, should be preceded by a section heading in upper case, without underlining or bold type.

**Detailed Action**

In the instant case, applicant should leave out of the specification the information and headings pertaining to numbers 2 and 3 from paragraph (c) of this section, unless of course there is information available. Further, for the title, applicant should simply leave out of the specification the introductory portion as set forth in number 1 from paragraph (c) of this section.

B. The disclosure is objected to as the spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.

C. The disclosure is objected to as the pages of the specification are not numbered. New application papers with the papers numbered sequentially on good quality paper are required.

D. Page 1, lines 14-19, Applicant states the instant plant is a branch sport from the species "Sedum purpureum". However, it doesn't appear that the instant plant was a sport of an entire species. It appears the instant plant may have been a branch sport from an unnamed plant of Sedum purpureum. Applicant should set forth in the specification the name of the parental cultivar, if named. If not named applicant should set forth in the specification something similar to the previous sentence.

**Detailed Action**

Further, applicant has not stated whether the instant plant was an induced mutation or a naturally occurring mutation. Applicant should set forth in the specification information regarding whether the instant plant was an induced sport or a naturally occurring sport. If such mutation was induced, applicant should set forth the artificial mutagen(s) and methodology which was used to arrive at the instant plant. If such mutation was naturally occurring, applicant could import into the specification a statement such as, for example, if accurate, "The instant plant was a naturally occurring branch sport of". The origin of the plant should be clearly and unambiguously set forth in the specification.

E. Applicant is requested to set forth in the specification whether the parental cultivar and closest known comparison cultivar, 'Frosty Morn', has been patented in the United States, is currently the subject of a pending U.S. Plant Patent application, or unpatented. If patented, --(U.S. Plant Patent No.)-- should be inserted after the cultivar name. If the subject of a pending application, such should be referred to by serial number. If unpatented, --(unpatented)-- should be inserted after the cultivar name.

F. Applicant should import into the specification a brief comparison between the instant plant and the parental cultivar, such need not be in any great detail, but should at least be to the extent necessary to positively distinguish the respective plants from each other.

**Detailed Action**

G. Page 1, lines 16-22, The asexual reproductions of the instant cultivar must reproduce true to the original 'Pink Chablis' in successive generations in order to receive a U.S. Plant Patent. If such is true then applicant should import into the specification a statement such as, if accurate, --'Pink Chablis' reproduces true to type in successive generations.--. Correction and/or clarification is necessary.

H. Page 1, lines 25-29, Applicant should set forth in the specification the age of the plants when described and the container size in which they were grown.

I. Page 1, lines 38-40, Applicant should set forth in the specification separate descriptions for each of the photographic illustrations provided. As such, applicant should delete lines 38-40 of page 1 and replace them with the following, if accurate:

--Figure 1 depicts a top perspective view of 'Pink Chablis'.

Figure 2 depicts flowers and foliage of 'Pink Chablis'.

Figure 3 depicts plants of the comparison cultivar 'Frosty Morn'.

Figure 4 depicts a side perspective view of the comparison cultivar 'Frosty Morn'.--.

J. Applicant should set forth in the specification the time it takes to produce a finished plant.



**Detailed Action**

K. Applicant should set forth in the specification the typical and observed mature plant height, width/spread, and shape. Height should be measured from soil level to the top of the foliage plane and from soil level to the top of the inflorescences.

L. Page 2, lines 5-19, Applicant should set forth in the specification additional information relative to the instant plant's leaves including the typical and observed immature and mature apex and base descriptor, and mature margin descriptor.

M. Page 2, lines 5-19, Applicant sets forth in the specification color designations for the immature and mature foliage. However, applicant has not set forth whether the color designations are for the upper, lower, or both surfaces. Applicant should set forth in the specification color designations for the upper and lower surfaces of the immature and mature foliage.

N. Page 2, lines 5-19, Applicant should set forth in the specification additional information relative to the instant plant's petioles including the typical and observed petiole length for immature and mature leaves.

**Detailed Action**

O. Page 2, lines 21 and 22, Applicant states flowers last from August through September. It is uncertain if applicant means the inflorescences last from August through September or the individual flowers last from August through September. Applicant should set forth in the specification the lastingness of an individual flower, on the plant.

P. Page 2, lines 22 and 23, Applicant sets forth in the specification two different stem diameters. It appears the stem would have the same diameter, unless applicant is intending the dimensions set forth to be from two different locations on the stem. If such is the case, applicant should state this in the specification. Correction and/or clarification is necessary.

Q. Page 2, lines 26-32, Applicant should set forth in the specification information relative to the instant plant's peduncles and pedicels including the typical peduncle and pedicel length, diameter, and coloration with reference to the employed color chart.

R. Page 2, lines 26-32, Applicant should set forth in the specification additional information relative to the instant plant's inflorescences including the typical and observed type, height, diameter, and number of flowers per inflorescence.

**Detailed Action**

Further, applicant has stated the instant plant's inflorescence is a panicle, however, when compared to the photographic illustration the inflorescence appears to be a compound cyme.

Correction and/or clarification is necessary.

S. Page 2, lines 26-32, Applicant should set forth in the specification additional information relative to the instant plant's flowers including the typical and observed petal shape, length, width, apex, base, and margin descriptor, and coloration (both surfaces) with reference to the employed color chart.

T. Page 2, lines 31 and 32, Applicant should set forth in the specification additional information relative to the instant plant's sepals including the typical and observed sepal shape, apex, base, and margin descriptor and coloration (both surfaces) with reference to the employed color chart. The recitation "white" is vague and insufficient in this regard.

U. Page 2, lines 30-32, Applicant should set forth in the specification additional information relative to the instant plant's flower reproductive organs including stigma, styles, and ovary/ies, (such as quantity, size and coloration of organs) with reference to the employed color chart. Applicant should also state whether pollen is produced. If pollen is produced, such should

**Detailed Action**

be accounted for by setting forth in the specification the amount produced, i.e. scarce, moderate, abundant, and coloration with reference to the employed color chart.

V. Page 2, lines 33 and 34, Applicant should set forth in the specification additional information relative to the instant plant's fruit including the typical and observed fruit amount and coloration with reference to the employed color chart.

W. Applicant should set forth in the specification information relative to the instant plant's flower buds including the typical and observed shape, length, diameter, and coloration with reference to the employed color chart.

X. Applicant should set forth in the specification information relative to the instant plant's resistance/susceptibility to disease/pests.

Y. Applicant should set forth in the specification information relative to the instant plant's winter hardiness.

Z. The Claim should be directed to "the plant". The following claim is typical for a U.S. Plant Patent and is suggested:

**Detailed Action**

--A new and distinct *Sedum purpureum* plant named 'Pink Chablis' as illustrated and described.--.

The additional information which applicant states in the claim is unnecessary as the claim is directed to "the plant" as "illustrated and described".

The above listing may not be complete. Applicant should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

**Claim Rejection**

**35 U.S.C. 112, 1st & 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

**Comments**

Due to the amount of revision seen necessary in this application, it is suggested that Applicant file a substitute specification, incorporating all additions, deletions and modifications so as to provide the printer a clean copy at the time of allowance. Applicant should specifically

**Detailed Action**

authorize cancellation of the present specification to the same. Further, a clean copy and marked up copy (showing any addition, deletion, and/or modification) of the substitute specification should be submitted.

**Future Correspondence**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (703) 306-3224. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205.

The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

K. L. Bell

**KENT BELL  
PRIMARY EXAMINER**

*Kent L. Bell*